APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/148,474	09/08/1998	EIJI TAKASU		3424

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EXAMINER
PAULA, CESAR B

ART UNIT	PAPER NUMBER
2178	28

DATE MAILED: 04/08/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

PTO-90C (Rev. 10/03)

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE <u>3</u> MONTH(S) FROM
THE MAILING DATE OF THIS COMMUNICATION.
- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed
  after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
  Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any
  earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on <u>26 January 2004</u>.

2a)☒ This action is **FINAL**. 2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is
closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) <u>1-31</u> is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) <u>1-31</u> is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage
application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)

2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)

3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____.

4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.

5) ☐ Notice of Informal Patent Application (PTO-152)

6) ☐ Other: _____.

DETAILED ACTION

1.   This action is responsive to the amendment filed on 1/26/2004.

This action is made Final.

2.   In the amendment, claims 1-31 are pending in the case. Claims 1, 10, 14, 26, and 30-31

are independent claims.

3.   The rejections of claims 1-31 under 35 U.S.C. 103(a) as being unpatentable over Mosher

view of Linking Handwriting Annotation with Text, IBM TDB, vol.32, No.6A, pp.452-454,

11/1989, and further in view of Forcier (Pat. # 5,590,257, 12/31/96) have been withdrawn as

necessitated by the amendment.

Priority

4.   Acknowledgment is made of applicant's claim for foreign priority under 35

U.S.C. 119(a)-(d), and based on application # 9-243,991 **filed in Japan on 9/9/1997**, which

papers have been placed of record in the file.

Claim Rejections - 35 USC § 103

5.   The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all

obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in
> section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are
> such that the subject matter as a whole would have been obvious at the time the invention was made to a person
> having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the
> manner in which the invention was made.

6.   Claims 1-31 are rejected under 35 U.S.C. 103(a) as being unpatentable over "MS

Exchange Users Handbook", Mosher, 29th Street Press, (saving, and replying to messages,

3/1/1997), in view of Lopresti et al, hereinafter Lopresti (Pat. # 5,889,506, 3/30/1999, filed on

10/25/1996).

        Regarding independent claim 1, Mosher discloses: *storing a received mail document --*

"You can save messages ......" (p.1, 3-4, fig.12.9). The messages include different formats, such

as the rich text format-- ".rtf", which allows the preservation of all the email message formatting.

In other words, the received email message is displayed—*dynamically reproduced*-- using the

exact same formatting of the original email message, as sent by its creator. Mosher fails to

explicitly teach *ink data and overlaid on a text image....ink data including coordinate*

information of each ink image and time information comprising a reproduction time for each ink

image, a reproduction position of the ink image being defined by the coordinate information on

reference coordinate axes of the received mail document, and reproduction speed of the ink

image being defined by the time information. However, Lopresti teaches the overlaying of ink or

handwritten map over ink text data (fig.17). Lopresti also teaches a user drawing handwritten

messages to be sent via the Internet. The handwritten messages—*ink data*-- are represented as

spatial and temporal components of user drawn pen strokes—*ink image*--, which include strokes'

positional data ("x, y")—*coordinate information on coordinate axes*-- associated with a time

value ("t") —*time information comprising reproduction time*-- (col. 6, lines 40-52, col. 11, lines

1-9, and col. 12, lines 33-65).   Temporal data is stored in terms of a next succeeding sampling

time, which basically represents how fast strokes are to be displayed—*reproduction speed of the ink image being defined by the time information*--. It would have been obvious to one of ordinary skill in the art at the time of the invention to have combined the email system of Mosher, and Lopresti, because Lopresti teaches above the benefit of sending of personalized messages, which are more accessible than typed electronic mail, and that a writing pen is more powerful than typed email, such as the creation of drawings as part of the email.

Moreover, Mosher discloses: inserting a character string to email text data when a new email is prepared --"Figure 12.9 When you reply to a message....indenting the message text and including header " (p.4, and 7). Mosher fails to explicitly teach *calculating a coordinate shift amount of the dynamic reproduction position of the ink image.* Lopresti teaches a user drawing handwritten messages to be sent via the Internet (col. 6, lines 40-52, col. 11, lines 1-9, and col. 12, lines 33-65). It would have been obvious to one of ordinary skill in the art at the time of the invention to have combined the email system of Mosher, and the interchanging or corresponding of handwritten email messages by Lopresti, and had shifted the handwritten email message-- *calculating a coordinate shift amount of the dynamic reproduction position of the ink image,* because Lopresti teaches above the benefit of sending of personalized messages over the Internet, which are more accessible than typed electronic mail, and that a writing pen is more powerful than typed email, such as the creation of drawings as part of the email.

Moreover, Mosher discloses: inserting a character string into email text data when a new email is prepared --"**Figure 12.9** When you reply to a message....indenting the message text and including header " (p.4, and 7). In other words, a new email document is created by shifting down in the new email a previously received email message. Mosher fails to explicitly teach

outputting, as the new document, the ink image which is overlaid on the new text image ...the

reproduction position of the ink image being executed based on the calculated coordinate shift

amount, the coordinate information and the time information. However, Lopresti teaches the

overlaying of ink or handwritten map over ink text data (fig.17). Lopresti also teaches a user

drawing the handwritten messages to be sent via the Internet. The handwritten messages—*ink*

data-- are represented, and stored as spatial and temporal components of user drawn pen

strokes—*ink image--*, which include strokes' positional data ("x, y")—*coordinate information--*

associated with a time value ("t") —*time information--* (col. 6, lines 40-52, col. 11, lines 1-9,

and col. 12, lines 33-65). It would have been obvious to one of ordinary skill in the art at the

time of the invention to have combined the email system of Mosher, and Lopresti, and had

shifted, and presented—*dynamic reproduction--* the overlaid ink/text as represented by the

coordinates(x-y), and time (t) of Lopresti, because Lopresti teaches above the benefit of sending

of personalized messages, which are more accessible than typed electronic mail, and that a

writing pen is more powerful than typed email, such as the creation of drawings as part of the

email.

Regarding claim 2, which depends on claim 1, Mosher discloses: "Figure 12.9 When you

reply to a message....indenting the message text and including header " (p.4). Mosher fails to

explicitly teach *the ink data comprises locus information to define the output position by*

coordinate values. Lopresti teaches a user drawing the handwritten messages to be sent via the

Internet. The handwritten messages—*ink data--* are represented, and stored as spatial (x, y

position data) *--locus information to define the output position by coordinate values--* and

temporal components (t) of user drawn pen strokes—*ink image--* (col. 6, lines 40-52, col. 11, lines 1-9, and col. 12, lines 33-65). It would have been obvious to one of ordinary skill in the art at the time of the invention to have combined the email system of Mosher, and Lopresti, because Lopresti teaches above the benefit of sending of personalized messages, which are more accessible than typed electronic mail, and that a writing pen is more powerful than typed email, such as the creation of drawings as part of the email.

Regarding claim 3, which depends on claim 1, Mosher discloses: "...how much text of the incoming message to quote ...." (p.3). Mosher fails to explicitly disclose: *....said character string to be inserted is a quotation symbol.* However, it would have been obvious to a person of ordinary skill in the art at the time of the invention to have included the quotation symbol, because Mosher teaches above, quoting text in a reply email message.

Regarding claim 4, which depends on claim 1, : "Figure 12.9 When you reply to a message....indenting the message text and including header " (p.4). When replying to an email, a user inserts a comment, such as "Thanks for the Update.."-- *an inserting comment text.*

Claims 5-9 are directed towards a method for implementing the steps found in claim 1, 1, 6, and are similarly rejected.

Claims 10-11 are directed towards a method for implementing the steps found in claims 1-2, and 1 respectively (where the ink data of claim 1 is equivalent to the locus information of claim 10), and are similarly rejected.

Claims 12-15, 17-22 are directed towards an information processing apparatus for implementing the steps found in claims (1-2), 2, and 1-2, and 4-9 respectively, and are similarly rejected.

Claim 16 is directed towards an information processing apparatus for implementing the steps found in claim 3, and is similarly rejected.

Regarding claim 23, which depends on claim 14, Mosher discloses: *output means is an inkjet printer--* (p.9). Mosher teaches use of a print file icon to print the email in a printer such as an inkjet printer.

Claims 24-29 are directed towards an information processing apparatus for implementing the steps found in claims 23, 1, 10-13 respectively, and are similarly rejected.

Claims 30-31 are directed towards a storage medium for storing instructions for implementing the steps found in claims 1, and 10 respectively, and are similarly rejected.

Response to Arguments

7.   Applicant's arguments with respect to claims 1-31 have been considered but are moot in

view of the new ground(s) of rejection. Regarding claims 1, 10, 14, 26, 30,and 31, the applicants

remark that the applied art does not disclose or suggest the calculation of a coordinate shift

amount as well as an output ink image (locus image)overlaid on a text image at a position shifted

according to the calculated amount (p.13, L. 3-7). Applicants are directed towards the rejection

of the newly amended claims above, in light of the new reference necessitated by the

amendment.

Further, the applicants note that no combination of the previously applied references

disclose the present invention (p.13, L. 12-17). Applicants are directed towards the rejection of

the newly amended claims above, in light of the new reference necessitated by the amendment.

Moreover, the applicants mention that Forcier is not seen teaching the reproduction of ink

data overlaid on a text image, and outputting an ink image, which is overlaid on a new text image

reproduced from text data (p.13, L. 21-26). Applicants are directed towards the rejection of the

newly amended claims above, in light of the new reference necessitated by the amendment.

Moreover, the applicants mention that Forcier does not calculate, and output a coordinate

shift amount for the output position of its handwritten annotations, and describing reproduction

time defining reproduction speed for the ink image (p.15, L. 1-12). Applicants are directed

towards the rejection of the newly amended claims above, in light of the new reference

necessitated by the amendment.

In addition, applicants remark that IBM does not disclose or suggest the calculating of a

coordinate shift amount for the output position, nor the output of the handwritten annotations

based on a calculated shift amount (p.16, L. 1-3). Applicants are directed towards the rejection

of the newly amended claims above, in light of the new reference necessitated by the

amendment.

All other dependent claims are rejected at least based on the rationale described above.

Conclusion

8.   Applicant's amendment necessitated the new ground(s) of rejection presented in this

Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a).

Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE

MONTHS from the mailing date of this action. In the event a first reply is filed within TWO

MONTHS of the mailing date of this final action and the advisory action is not mailed until after

the end of the THREE-MONTH shortened statutory period, then the shortened statutory period

will expire on the date the advisory action is mailed, and any extension fee pursuant to 37

CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event,

however, will the statutory period for reply expire later than SIX MONTHS from the date of this

final action.

I.   Any inquiry concerning this communication or earlier communications from the examiner

should be directed to Cesar B. Paula whose telephone number is (703) 306-5543. The examiner

can normally be reached on Monday through Friday from 8:00 a.m. to 4:00 p.m. (EST).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor,

Heather Herndon, can be reached on (703) 308-5186. However, in such a case, please allow at

least one business day.

Any inquiry of a general nature or relating to the status of this application or proceeding should

be directed to the Group receptionist whose telephone number is (703) 305-3900.

Any response to this Action should be mailed to:

> Commissioner for Patents
> P.O. Box 1450
> Alexandria, VA 22313-1450

Or faxed to:

o   **(703) 703-872-9306,** (for **all** Formal communications intended for entry)

**Hand-delivered responses should be brought to Crystal Park II, 2121 Crystal Drive,
Arlington, VA, Sixth Floor (Receptionist).**

STEPHEN S. HONG
PRIMARY EXAMINER

CBP

4/2/04